UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,125	10/31/2003	Julie A. Gannon	03-364	4999

719 7590 05/12/2008

Caterpillar Inc.
Intellectual Property Dept.
AH 9510
100 N.E. Adams Street
PEORIA, IL 61629-9510

EXAMINER	
CERVETTI, DAVID GARCIA	
ART UNIT	PAPER NUMBER
2136	

MAIL DATE	DELIVERY MODE
05/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/699,125	GANNON ET AL.	
	Examiner	Art Unit	
	DAVID CERVETTI	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments filed February 27, 2008 and December 27, 2007, have been fully considered but they are not persuasive.

2. Claims 1-51 are pending and have been examined.

Response to Amendment

3. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (US Patent 6,966,000, hereinafter Zhang), and further in view of Gilliam et al. (US Patent Application Publication 2004/0006542, hereinafter Gilliam).

Regarding claim 1, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:
- receiving a request to enable said software option **(abstract)**;
- authorizing said enablement **(abstract)**;
- delivering a first enabling signal in response to the authorization **(col. 5, lines 1-45)**; and
- delivering a second enabling signal to said machine in response to said first enabling signal **(col. 5, lines 45-67)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 24, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:
- receiving a request to enable said software option **(abstract)**;
- authorizing said request **(abstract)**;

- delivering an enabling signal to said remote machine **(col. 5, lines 1-45)**; and
- distributing at least a portion of said enabling signal to a plurality of controllers located on said remote machine **(col. 5, lines 45-67)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 27, Zhang teaches

- a method of enabling a software option located on a replacement processor of a remote machine **(abstract)**, comprising the steps of:
- identifying a failed processor associated with said replacement processor **(col. 6, lines 7-40)**;
- receiving a request to enable said software option **(abstract)**;
- authorizing said request in response to said identified failed processor **(abstract)**; and
- delivering an enabling signal to said replacement processor in response to said authorization **(col. 5, lines 1-45)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 30, Zhang teaches

- a method of providing an entitlement for an enabled software option located on a remote machine **(abstract)**, comprising the steps of:
- receiving a request to disable said software option **(col. 6, lines 7-40)**;
- disabling said software option **(col. 6, lines 7-40)**;
- receiving a disabled characteristic associated with said software option **(col. 6, lines 7-40)**; and
- establishing an entitlement in response to said disabled characteristic **(col. 7, lines 1-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional

functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 39, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:
- receiving a request to enable said software option **(abstract)**;
- enabling said software option during a trial period **(col. 7, lines 20-47)**;
- notifying a user with respect to an expiration of said trial period **(col. 7, lines 20-47)**;
- receiving a request to enable said software option in response to said notification; authorizing said request **(col. 7, lines 20-47)**; and
- delivering an enabling signal to said remote machine **(col. 7, lines 20-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 43, Zhang teaches

- a method of disabling a software option located on a remote machine **(abstract)**, comprising the steps of:
- receiving a request to disable said software option **(col. 6, lines 7-40)**;
- disabling said software option **(col. 6, lines 7-40)**; and
- receiving a disabled characteristic associated with said software option **(col. 7, lines 1-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 44, Zhang teaches

- a method of enabling a software option located on a remote customer machine **(abstract)**, comprising the steps of:
- receiving a request by a manufacturer from a dealer to enable said software option **(col. 7, lines 20-47)**;
- authorizing said request in response to a dealer characteristic and a machine characteristic **(col. 7, lines 20-47)**; and

- delivering an enabling signal to said remote customer machine **(col. 7, lines 20-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 49, Zhang teaches

- a method of enabling a software option located on a remote machine **(abstract)**, comprising the steps of:
- establishing a machine specific configuration **(col. 4, lines 23-57)**;
- generating a request to enable said software option in response to said machine specific configuration **(col. 4, lines 23-57, col. 5, lines 45-67)**,
- said request being authorized at a remote location **(col. 7, lines 20-47)**; and
- receiving an enabling signal at said machine in response to said authorization, said enabling signal being verified by an intermediary **(col. 7, lines 20-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 50, Zhang teaches

- a method of enabling a software option located on a first machine **(abstract)**, comprising the steps of:
- establishing a need for said software option on said first machine **(col. 7, lines 20-47)**;
- delivering a request for said software option to a second machine **(col. 7, lines 20-47)**;
- disabling said software option on said second machine in response to said request **(col. 6, lines 7-40)**;
- generating an enabling signal in response to said disablement **(col. 4, lines 23-57, col. 5, lines 45-67)**; and
- enabling said software option on said first machine in response to said enabling signal **(col. 7, lines 20-47)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 51, Zhang teaches

- a system configured to enable a software option located on a remote machine **(abstract)**, comprising;
- a controller located on said remote machine **(col. 3, lines 40-67)**,
- said controller being configured to generate a request to enable said software option **(col. 3, lines 40-67)**;
- a remote facility configured to receive said request, authorize said request **(col. 7, lines 20-47)**; and
- generate a first enabling signal **(col. 5, lines 1-45)**; and
- configured to receive said first enabling signal, authenticate said signal, and responsively deliver a second enabling signal to said machine in response to said first enabling signal **(col. 5, lines 1-45)**.

Zhang does not expressly disclose an intermediary, however, Gilliam teaches an intermediary for activating software **(fig.1, license server, activation server, vendor, and client, pars. 36-41)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have additional servers performing additional functions on the system of Zhang. One of ordinary skill in the art would have been motivated to perform such a modification to enforce intellectual property rights on distributed software **(Gilliam, pars. 14-20)**.

Regarding claim 2, the combination of Zhang and Gilliam teaches wherein said intermediary authenticates said enabling signal **(Zhang, col. 5, lines 1-45)**.

Regarding claim 3, the combination of Zhang and Gilliam teaches wherein the step of delivering said second signal further comprises the step of delivering said second signal in response to said authenticating said first enabling signal **(Zhang, col. 6, lines 7-40)**.

Regarding claim 4, the combination of Zhang and Gilliam teaches establishing a machine specific configuration; and generating said software option request in response to said machine specific configuration **(Zhang, col. 6, lines 7-40)**.

Regarding claim 5, the combination of Zhang and Gilliam teaches delivering said second enabling signal to a controller located on said machine **(Zhang, col. 5, lines 45-67)**.

Regarding claim 6, the combination of Zhang and Gilliam teaches wherein said request is generated by a software program needing said software option **(Zhang, abstract)**.

Regarding claim 7, the combination of Zhang and Gilliam teaches wherein the step of delivering said second signal further comprises the step of delivering said second signal to a plurality of controllers located on said remote machine **(Zhang, col. 5, lines 45-67)**.

Regarding claim 8, the combination of Zhang and Gilliam teaches initiating a billing process in response to said authorization **(Zhang, col. 8, lines 1-23)**.

Regarding claim 9, the combination of Zhang and Gilliam teaches determining if one of an entitlement and a credit is available in response to said billing process initiation **(Zhang, col. 8, lines 1-23)**.

Regarding claim 10, the combination of Zhang and Gilliam teaches authorizing said enablement in response to an entitlement associated with said software option **(Zhang, col. 8, lines 1-23)**.

Regarding claim 11, the combination of Zhang and Gilliam teaches wherein said intermediary is a gateway network **(Zhang, col. 5, lines 1-45)**.

Regarding claim 12, the combination of Zhang and Gilliam teaches generating said request in response to a controller failing **(Zhang, col. 6, lines 7-40)**.

Regarding claim 13, the combination of Zhang and Gilliam teaches wherein said request includes a failed controller characteristic and a replacement controller characteristic **(Zhang, col. 6, lines 7-40)**.

Regarding claim 14, the combination of Zhang and Gilliam teaches wherein the step of authorizing said enablement further includes the step of authorizing said enablement for a time period **(Zhang, col. 5, lines 45-67)**.

Regarding claim 15, the combination of Zhang and Gilliam teaches wherein the step of receiving said request further comprises the step of receiving said request from a dealer associated with said machine **(Zhang, col. 5, lines 45-67)**.

Regarding claim 16, the combination of Zhang and Gilliam teaches wherein the step of authorizing said enablement further includes the step of authorizing said enablement by a manufacturer associated with said machine **(Zhang, col. 6, lines 7-40)**.

Regarding claim 17, the combination of Zhang and Gilliam teaches generating a request to enable said software option by a first machine **(Zhang, col. 6, lines 7-40)**.

Regarding claim 18, the combination of Zhang and Gilliam teaches disabling said software option on a second machine in response to said enablement authorization **(Zhang, col. 8, lines 1-41)**.

Regarding claim 19, the combination of Zhang and Gilliam teaches wherein the step of delivering said first enabling signal further comprises the step of delivering said first enabling signal in response to said disabling of said software option **(Zhang, col. 8, lines 1-41)**.

Regarding claim 20, the combination of Zhang and Gilliam teaches scheduling a delivery of said first enabling signal **(Zhang, col. 7, lines 20-67)**.

Regarding claim 21, the combination of Zhang and Gilliam teaches wherein the step of scheduling said delivery further comprises the step of scheduling said delivery in response to a priority of said request **(Zhang, col. 8, lines 1-24)**.

Regarding claim 22, the combination of Zhang and Gilliam teaches wherein the step of scheduling said delivery further comprises the step of scheduling said delivery in response to a priority of said request and a priority associated with a current use of said software option **(Zhang, col. 8, lines 1-41)**.

Regarding claim 23, the combination of Zhang and Gilliam teaches delivering a notification to said first machine, said notification including an indication of when said request may be fulfilled **(Zhang, col. 5, lines 45-67)**.

Regarding claim 25, the combination of Zhang and Gilliam teaches wherein said software option is associated with said plurality of processors **(Zhang, col. 4, lines 1-35)**.

Regarding claim 26, the combination of Zhang and Gilliam teaches wherein the step of delivering an enabling signal to said remote machine further comprises the step of delivering said enabling signal to a primary processor, and further wherein said primary processor delivers a second enabling signal to said at least one other processor **(Zhang, col. 7, lines 20-47)**.

Regarding claim 28, the combination of Zhang and Gilliam teaches wherein said request includes at least one of a failed controller identifier and a replacement controller identifier **(Zhang, col. 6, lines 7-40)**.

Regarding claim 29, the combination of Zhang and Gilliam teaches wherein the step of authorizing said request includes the steps of: authenticating said failed controller identifier and said replacement controller identifier, and confirming the requested software option was enabled on said failed controller **(Zhang, col. 5, lines 1-45, col. 6, lines 7-40)**.

Regarding claim 31, the combination of Zhang and Gilliam teaches wherein said entitlement is associated with said disabled software option **(Zhang, col. 8, lines 1-45)**.

Regarding claim 32, the combination of Zhang and Gilliam teaches authenticating said disabled characteristic **(Zhang, col. 6, lines 40-67)**.

Regarding claim 33, the combination of Zhang and Gilliam teaches wherein the step of establishing an entitlement further comprises the step of establishing said entitlement in response to said authentication **(Zhang, col. 6, lines 40-67)**.

Regarding claim 34, the combination of Zhang and Gilliam teaches receiving a request to enable a software option on a second machine; and authorizing said request in response to said entitlement **(Zhang, col. 6, lines 40-67)**.

Regarding claim 35, the combination of Zhang and Gilliam teaches authenticating said request in response to a controller characteristic and a software option status; and generating a disable signal in response to said authentication **(Zhang, col. 6, lines 40-67)**.

Regarding claim 36, the combination of Zhang and Gilliam teaches wherein the step of disabling said software option further comprises the step of disabling said

software option in response to said disable signal and a machine status **(Zhang, col. 6, lines 40-67)**.

Regarding claim 37, the combination of Zhang and Gilliam teaches wherein said machine status includes one of power up and power down **(Zhang, col. 6, lines 40-67)**.

Regarding claim 38, the combination of Zhang and Gilliam teaches wherein said machine status includes an implement status **(Zhang, col. 7, lines 27-67)**.

Regarding claim 40, the combination of Zhang and Gilliam teaches generating a disable signal in response to said trial period expiration **(Zhang, col. 7, lines 20-47)**.

Regarding claim 41, the combination of Zhang and Gilliam teaches disabling said software option in response to said disable signal and a machine status **(Zhang, col. 6, lines 40-67)**.

Regarding claim 42, the combination of Zhang and Gilliam teaches wherein said machine status includes one of power up and off **(Zhang, col. 6, lines 40-67)**.

Regarding claim 45, the combination of Zhang and Gilliam teaches wherein the step of delivering an enabling signal to said remote machine further comprises the steps of: delivering an enabling signal to said dealer in response to said authorization; and delivering said enabling signal to said remote machine in response to said dealer receipt **(Zhang, col. 7, lines 20-47)**.

Regarding claim 46, the combination of Zhang and Gilliam teaches wherein said dealer characteristic includes at least one of a service tool identifier, a service representative identifier, a dealer identifier, and a cross reference identifier of said dealer and said customer **(Zhang, col. 7, lines 20-47)**.

Regarding claim 47, the combination of Zhang and Gilliam teaches wherein said machine characteristic includes at least one of a software option identifier, a processor identifier, and a configuration identifier **(Zhang, col. 7, lines 28-67)**.

Regarding claim 48, the combination of Zhang and Gilliam teaches wherein said step of authorization further includes the step of authorizing said request in response to a machine characteristic, a dealer characteristic, and a user characteristic **(Zhang, col. 7, lines 20-47)**.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chavez (2004/0172367) teaches a method of license distribution and transferring of licenses between endpoints.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID CERVETTI whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/
Examiner, Art Unit 2136

/Brandon S Hoffman/
Primary Examiner, Art Unit 2136